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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,242	10/09/2003	Adam A. Monroe	121817.0001.088	1002

7590                      07/20/2006

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EXAMINER	
DINH, DUC Q	

ART UNIT	PAPER NUMBER
2629	

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/682,242	<b>Applicant(s)</b> MONROE, ADAM A.	
	<b>Examiner</b> DUC Q. DINH	<b>Art Unit</b> 2629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. This Office Action is responsive to the Amendment filed on May 2, 2006. Claims 1-20 are pending in the Application. Claim 1 is currently amended, claims 2-20 are newly added and being examined as follows.

### *Double Patenting*

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,633,282. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claimed the same subject matter as following.

Claim 1 of the current pending application	Claim 1 of the U.S Patent No. 6,333,282
A method for permitting the entry of manually generated alphanumeric and graphic data into a computer system, comprising:	An apparatus adapted for permitting the entry of manually generated alphanumeric and graphic data into a computer system comprising:
employing a housing having opposite ends;	a. a housing having opposite ends;
engaging a writing instrument contained within the housing;	b. a writing instrument contained within the housing and presenting a writing tip at one end of the housing for writing upon a writing surface;
detecting the position of the writing tip with respect to a writing surface using an intergral sensor system; and	c. a sensor system for detecting the position of the writing tip with respect to a writing surface and for detecting changes in position of the writing tip with respect to the writing surface; and
transmitting the position of the writing tip with respect with the writing surface to the computer system	d. a transmission system for transmitting the position of the writing tip to the computer system

It would have been obvious for one of ordinary skill in the art at the time of the invention to use the claimed apparatus of the U.S Patent No. 6,633,282 to produce the method for permitting the entry of manually generated alphanumeric and graphic data into a computer system in the currently pending application.

Similar comparisons are applied to claims 2-20 of the currently application and claims 2-20 of the U.S Patent No. 6,633,282.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Connor et al. (U.S Patent No. 6,188,392), hereinafter O'Connor.

In reference to claim 1, O'Connor discloses an apparatus for permitting the entry of manually generated alphanumeric and graphic data into a Computer system, comprising:

employing a housing (102) having opposite ends (see Fig. 1)

engaging a writing instrument (tip 104 having a ball-point type with ink cartridge (col. 3, lines 61-63) contained within the housing (102);

presenting a writing tip (104) at one end of the housing for writing upon a writing surface (106);

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detecting the position of the writing tip (104) with respect to a writing surface using an internal sensor system (sensor 108, 113 and 114)

detecting changes in position of the writing tip with respect to the writing surface (col. 4, lines 25-40);

transmitting the position of the writing tip to the computer system (col. 6, lines 9-13).

In reference to claim 2, O'Connor discloses detecting the position of the writing tip further comprising defining the position of the writing instrument using an orthogonal coordinate system (col. 4, lines 24-32).

In reference to claim 3, O'Connor discloses detecting a pressure applied by the writing tip to the writing surface in a z direction; and transmitting the detected pressure to the computer system (see col. 4, lines 50-62) .

In reference to claim 4, O'Connor disclose measuring a rotation of the writing instrument relative to the X and Y coordinates (col. 4, lines 51-64 and Fig. 6).

In reference to claim 5, O'Connor discloses transmitting at least one signal indicative of writing tip position to the computer system via an integrated antenna (using Radio Frequency signal inherently using antenna to transmit signal to computer as shown in Fig. 2).

In reference to claim 6, O'Connor discloses wherein the writing instrument comprises an ink cartridge integrated with a rotating ball element (col.3, lines 64-66), and further wherein detecting changes in a position of the writing tip comprises monitoring a deflection and a surface speed of the ball (col. 4, lines 26-40).

In reference to claim 7, O'Connor discloses a system (Figs. 1-2) for detecting, defining and transmitting a position of a writing tip, relative to a known location on a writing surface, to record manually generated alphanumeric and graphic data; comprising:

a modified pen housing (pen housing 102 in Fig. 1);

a dual purpose writing instrument (pen in Fig. 1), having the writing tip (104) for generating the alphanumeric and graphic data (col. 1, lines 5-10);

a plurality of sensors (108, 112 in 113 Figs. 1 and 2) for detecting a position of the writing tip (104) with respect to the writing surface, and for detecting changes in the position of the writing tip (col. 5, lines 13-26);

a transmission device (119 in Fig. 2) for transmitting one or more signals representative of the position of the writing tip and the changes in the position of the writing tip; and

a computer system (130) for receiving the transmitted signals, and for processing the signals to define the position of the writing tip (Fig. 2, col. 6, lines 16-23).

In reference to claim 8, O'Connor discloses the dual purpose writing instrument further comprises a ball point and ink cartridge for marking data on the writing surface (col. 2, lines 61-66).

In reference to claim 9, O'Connor discloses the transmission device includes at least one electrical wire interconnected with the computer system (see Fig. 7).

In reference to claim 10, O'Connor discloses wherein the transmission device is wireless (see wireless connection 119 in Fig. 2).

In reference to claim 11, O'Connor discloses wherein the plurality of sensors further comprises: a first sensor (113) for detecting an x coordinate of the writing tip according to an orthogonal coordinate system; and a second sensor (114) for detecting a Y coordinate of the writing tip according to the orthogonal coordinate system (col. 4, lines 26-40).

In reference to claim 12, O'Connor discloses a sensor (113 and 114) for detecting a Z coordinate of the writing tip according to the orthogonal coordinate system (col. 4, lines 56-66).

In reference to claim 13, O'Connor discloses, wherein the first and the second sensors are deflection sensors; and further wherein each deflection sensor includes a calibrated index particular to the sensor (sensor 112 and 113 may be connected to the inner wall of the housing or to the support structure of the housing, accordingly, the sensors are free to align themselves, i.e. calibrate index particular to the sensor, parallel to the normal 144, when angle 199 is changed by user of the pen; see col. 7, lines 30-40).

In reference to claim 14, O'Connor discloses the each of the sensor 113 and 114 is speed sensor for measuring a speed with while a position of the writing tip changes (col. 4, lines 26-32).

In reference to claim 15, O'Connor discloses a power source (battery 122 in Fig. 1) integrated into the modified housing.

In reference to claim 16, O'Connor discloses a method of manufacturing a device for detecting, defining and transmitting a position of a writing tip relative to a known location on a writing surface, to record manually generated alphanumeric and graphic data comprising:

modifying a standard ball point pen housing (102 see Fig. 1 and 2) to receive a writing instrument having the writing tip (104);



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positioning the writing instrument within the housing;

interconnecting the writing instrument (100) to a power source (battery 122 in Fig. 1) within the housing (102),

integrating a plurality of sensors (108, 113, 114) with the writing instrument (100) to detect and define a position, and a change of position, of the writing tip of the writing instrument (see col. 4, lines 5-40).

electrically connecting the plurality of sensors (108, 113, 114) to a transmission device (119 see Fig. 2) collocated with the writing instrument (100).

In reference to claim 17, O'Connor discloses comprising locating an antenna (for transmitting the RF signal in 119) in the housing (102) to transmit electrical signals representative of a position of the writing tip to a remote computer (130; see col. 6, lines 3-22).

In reference to claim 18, O'Connor discloses the system comprises: a first sensor for detecting an x coordinate of the writing tip according to an orthogonal coordinate system; and a second sensor for detecting a Y coordinate of the writing tip according to the orthogonal coordinate system (see rejection applied to claim 11).

In reference to claim 19, O'Connor discloses an integrating sensor for detecting a z coordinate of the writing tip according to the orthogonal coordinate system (col. 4, lines 51-67)

In reference to claim 20, O'Connor discloses incorporating a speed sensor (acceleration sensor 113, 114) into the device to measure the speed with which a position of the writing tip changes (col. 4, lines 26-32).

### ***Conclusion***

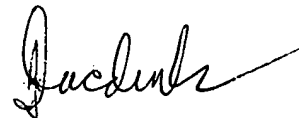
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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DUC Q DINH whose telephone number is (571) 272-7686. The examiner can normally be reached on Mon-Fri from 8:00.AM-4:00.PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe can be reached on (571) 272-7691. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DUC Q DINH  
Examiner  
Art Unit 2629



DQD  
July 14, 2006